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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,135	02/15/2000	Suthirug Num Pisutha-Armond	CS10006	7503
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MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER WEST, LEWIS G	
			ART UNIT 2618	PAPER NUMBER
			NOTIFICATION DATE 11/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/504,135

Applicant(s)

NUM PISUTHA-ARNOND ET AL.

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35,37-42 and 44-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35,37-42 and 44-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Response to Arguments

Applicant's arguments filed September 16, 2007 have been fully considered but they are not persuasive.

Applicant has failed to remove the new matter, or correct the 101 rejections, therefore the previous rejection is maintained and this action is made final.

Applicant is not merely changing the wording from the specification but is piecing together unrelated embodiments to form claim language which reflects an invention which applicant did not possess at the time of filing and is therefore new matter. Further adding to the claim presents even more limitations not found in combination with the existing limitations in the claim and no specific support has been provided from the specification for these limitations. Adding more new matter does not correct previous new matter rejections. Applicant cites extrinsic evidence which is irrelevant to showing support in applicant's original specification. If applicant does have support then the burden is upon applicant to show said specific support, and applicant while arguing portions which conflict with applicant's position, fails to show any evidence in the specification to support this position or show any citation of the original specification to support the added claim language.

Mere arguments that it is not new matter are not sufficient, see MPEP 2145:

2145 [R-3] Consideration of Applicant's Rebuttal Arguments

I. ARGUMENT DOES NOT REPLACE EVIDENCE WHERE EVIDENCE IS
NECESSARY

Attorney argument is not evidence unless it is an admission, in which case, an examiner

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may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

As all arguments since the board decision are based on new matter, therefore the previous art rejection is maintained, as the applied art was upheld by the board of appeals.

As previously explained in the rejection there is no tangible output claimed. Therefore this rejection is also maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35, 37-42 and 44-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. From the amendments to claims of July 10, 2006, in claims 35 and 42, “wherein the type of message is different than the size of the message” is not supported by the original specification and is therefore new matter. From the further amendments filed October 19, 2006, the “criteria of the type” limitations are also not supported by the original specification. The original specification specifically indicates that the “quickview” is performed based on the type of message which is directly based on the size of the message. Further applicant has not shown specification support for the newly added limitations regarding intended receipt and no such support has been found, this is also new matter. All new matter must be **removed**.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35, 37-42 and 44-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is non-statutory because it is an **abstract idea**, directed solely to **non-functional descriptive material**.

Claims 35 and 37-41 are directed to performing an algorithm. The routine, as claimed, only describes a series of steps to be performed by a computer, but with no **tangible** output.

Claim 42 and 44-48 are directed to similar method steps and is therefore also directed to a series of steps with no **tangible** output.

“generating a display item” is not a tangible output, as it does not expressly reflect any tangible output to a piece or hardware which may be seen by a user. Therefore the claimed

invention in both groups is abstract, as it may take place completely inside a computer with no useful output.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35, 37-42 and 44-48 are rejected under 35 U.S.C. 102(b) as being anticipated by ICHIKAWA et al (US 4,626,842 A).

Regarding claim 35, ICHIKAWA et al discloses message alert system for a communication device (all elements of figure 1) wherein the communication device comprises a processor (element 4 of figure 1 and column 2 lines 42-46) and a display (element 8 of figure 1) for displaying information, comprising: a computer-readable medium (element 401 of figure 3); and a routine stored in the computer-readable medium and configured for execution by the processor, the routine comprising: a first routine that receives a message comprising the information (column 3 lines 62-67); a second routine that analyzes the message to determine from type identifying data transmitted with the message a size thereof (column 4 lines 8-32), and further analyzes the message to determine whether the message is of a message type for which the third routine is executed wherein the criteria for the type of message is different from a criteria based on the size of the message (Column 2 lines 26-46); a third routine that generates a

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display item for the message in accordance with the size thereof (column 5 lines 11-57), if the message is of the type for which the third routine is executed.

Regarding claim 37, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses an initialization routine that specifies the message type (based on number of digits) for which the third routine is executed (column 3 line 62 to column 4 line 32).

Regarding claim 38, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses that the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is less than a predetermined size (column 3 line 62 to column 4 line 32).

Regarding claim 39, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is greater than a predetermined size; and the routine comprises a fourth routine that provides the generated display item to the display for a predetermined time (column 3 line 62 to column 4 line 32).

Regarding claim 40, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses that the routine comprises a fifth routine that generates a further display item that comprises a portion of the message when the second routine determines that the size of the message is greater than a predetermined size; and the routine comprises a sixth routine that provides the further display item to the display after the predetermined time has elapsed (column 3 line 62 to column 4 line 32).

Regarding claim 41, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses that the message is transmitted to the communication device via a network; and the network is a broadcast network (column 2 line 27 to column 4 line 32).

Regarding claim 42, ICHIKAWA et al discloses a method of controlling a communication device (all elements of figure 1) having a display (element 8 of figure 1) for displaying information, the method comprising the steps of: receiving a message comprising the information (column 3 lines 62-67); analyzing the message to determine a size thereof, wherein the criteria for the type of message is different than a criteria based on the size of the message (Col. 3 line 62-Col. 4 line 7), and further analyzing the message to determine from type identifying data transmitted with the message whether the message is of a message type for which the generating step is executed (Column 2 lines 26-46); and generating a display item for the message in accordance with the size thereof (column 5 lines 11-57), if the message is of the type for which the generating step is executed.

Regarding claim 43, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses analyzing the message to determine whether the message is of a message type for which the generating step is executed (column 3 line 62 to column 4 line 32). This is read as when the message is limited to 10 digits.

Regarding claim 44, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses an initialization routine that specifies the message type (based on number of digits) for which the third routine is executed (column 3 line 62 to column 4 line 32).

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Regarding claim 45, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses that the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is less than a predetermined size (column 3 line 62 to column 4 line 32).

Regarding claim 46, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is greater than a predetermined size; and the routine comprises a fourth routine that provides the generated display item to the display for a predetermined time (column 3 line 62 to column 4 line 32).

Regarding claim 47, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses that the routine comprises a fifth routine that generates a further display item that comprises a portion of the message when the second routine determines that the size of the message is greater than a predetermined size; and the routine comprises a sixth routine that provides the further display item to the display after the predetermined time has elapsed (column 3 line 62 to column 4 line 32).

Regarding claim 48, see the rejection of the parent claim concerning the subject matter this claim depends from. ICHIKAWA et al further discloses that the message is transmitted to the communication device via a broadcast network (column 2 line 27 to column 4 line 32).

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

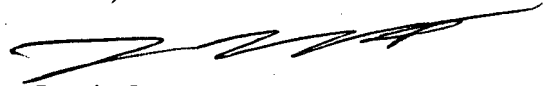
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lewis G. West
Primary Examiner
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